REMARKS

Claim 1 has been amended. Reconsideration of the application in response to the Examiner's Office Action is respectfully requested.

I. Claim Objections

In the Office Action, the Examiner has objected to Claim 1 as allegedly having several typographical errors. Applicant has amended Claim 1 in accordance with the Examiner's suggestions. Applicant respectfully submits that the amendments to Claim 1 effectively traverse the Examiner's objections. Such action is earnestly solicited.

II. Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph

In the Office Action, the Examiner has rejected Claim 1 under 35 U.S.C. § 112, 2nd paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner is confused to the meaning of "wherein said subject of said game of chance is a combined outcome of multiple sports games occurring within a plurality of specified consecutive time frames". Applicant has amended Claim 1 to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

III. Claim Rejections – 35 U.S.C. § 103(a)

In the Office Action, the Examiner has rejected Claims 1 and 3-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hannan et al., U.S. Patent Publication 2004/0029627 in view of Kail, U.S. Patent 6,015,345 and further in view of Tulley et al., U.S. Patent 6,688,976.. Applicant has amended independent Claim 1 to further distinguish Applicant's claimed system. In Claim 1, Applicant claims:

> A method of conducting a game of chance by a game of chance administrator wherein an entrant pays an entry fee and obtains a chance to win a predetermined, specified currency amount, said method comprising the steps of:
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> selecting a subject of said game of chance, said game of chance having a plurality of game playing identifiers over a predetermined regular season time frame;
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> wherein said subject of said game of chance is a combined outcome of one of a plurality of randomly selected individuals playing in a specified individual sporting event during said predetermined regular season time frame or a plurality of randomly selected team sports games occurring on a specified day of said predetermined regular season time frame, each of the plurality of game playing identifiers over a predetermined regular season time frame being one of a plurality of randomly selected individuals playing in a specified individual sporting event or a plurality of randomly selected team sports games occurring on a specified day;
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> establishing measured performance criteria relating to said subject of said game of chance;
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> establishing a number of participants *n* in said subject of said game of chance;
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> establishing a number of participants *r* whose measured performance will be combined for purposes of said game of chance;

determining each permutation *nPr* of *n* participants whose performances will be combined in groups of *r* in said game of chance;

creating a game record for each said permutation, the number of game records limited to the number of permutations;

assigning each said game record a unique game record identifier;

establishing a predetermined specified currency amount as a payout sum to be paid out to winning entrants with respect to each of the plurality of game playing identifiers;

creating a game record having each of said unique game record identifier and said plurality of game playing identifiers over said predetermined regular season time;

receiving said entry fee from an entrant in exchange for assignment to the entrant of one of said permutations, as evidenced by said unique game record identifier;

providing said entrant with said visual game record;

determining the at least one winning permutation following the events on which the game of chance is based; and

paying said predetermined specified currency amount as a fixed payout sum to two or more entrants holding winning permutations for a specific game playing identifiers over a predetermined regular season time frame wherein the winning permutations are one of a total highest finish of said plurality of randomly selected individuals playing in a specified individual sporting event or a total highest point total scored by said plurality of randomly selected team sports games occurring on a specified day.

Applicant respectfully submits that the Examiner's cited references neither shows nor discloses Applicant's claimed method. Applicant's method discloses conducting a game of chance by a game of chance administrator wherein an entrant pays an entry fee and obtains a chance to win a predetermined,

specified currency amount, said method selects a subject of said game of chance, **said game of chance having a plurality of game playing identifiers over a predetermined regular season time frame.** The subject of said game of chance is a combined outcome of **one of a plurality of randomly selected individuals playing in a specified individual sporting event during said predetermined regular season time frame or a plurality of randomly selected team sports games occurring on a specified day of said predetermined regular season time frame, each of the plurality of game playing identifiers over a predetermined regular season time frame being one of a plurality of randomly selected individuals playing in a specified individual sporting event or a plurality of randomly selected team sports games occurring on a specified day.** The game of chance pays the predetermined specified currency amount as a **fixed payout sum to two or more entrants holding winning permutations for a specific game playing identifiers over a predetermined regular season time frame wherein the winning permutations are one of a total highest finish of said plurality of randomly selected individuals playing in a specified individual sporting event or a total highest point total scored by said plurality of randomly selected team sports games occurring on a specified day.**

Nowhere in the cited prior art does it disclose a game of chance having a plurality of game playing identifiers over a

predetermined regular season time frame wherein each of the plurality of game playing identifiers over a predetermined regular season time frame being one of a plurality of randomly selected individuals playing in a specified individual sporting event or a plurality of randomly selected team sports games occurring on a specified day. Furthermore, none of the prior art references disclose a **fixed payout sum to two or more entrants holding winning permutations for a specific game playing identifiers over a predetermined regular season time frame wherein the winning permutations are one of a total highest finish of said plurality of randomly selected individuals playing in a specified individual sporting event or a total highest point total scored by said plurality of randomly selected team sports games occurring on a specified day.**

In contrast, Hannan et al. requires that the player select the top six finishers in a tournament (See [0012]) or selecting all four, five or six players in a finishing sequence (See [0013]), or selecting the six highest scoring teams in the NFL during a weekend (See [0019]). Hannan specifically states that the winning combination is based on skill and not on random selection (See [0001]).

Similarly, Kail discloses that a weekly or other regularly scheduled game of chance is conducted in conjunction with a series of seasonal sporting events, such as baseball, football,

hockey, U.S. and international basketball and volleyball games, in which a number of specific games are identified on a printed or electronic game card, and the participant marks the game card with the predicted total of points scored by both teams for each of the identified sporting events. Kail does not disclose a **fixed payout sum to two or more entrants holding winning permutations for a specific game playing identifiers over a predetermined regular season time frame wherein the winning permutations are one of a total highest finish of said plurality of randomly selected individuals playing in a specified individual sporting event or a total highest point total scored by said plurality of randomly selected team sports games occurring on a specified day.**

Furthermore, the legal standard for obviousness under 35 U.S.C. 103 has been the subject of much analysis. The Federal Circuit has enunciated several guidelines in making a Sec. 103 obviousness determination.

> A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.
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> In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed Cir. 1993) (quoting In re Rinehart, 531 F.2d 1048, 1051 (C.C.P.A. 1976)).
>
> {T}he examiner bears the burden of establishing a prima facie case of obviousness based upon the prior

> art. "{The Examiner} can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." (Emphasis added)
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> In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed Cir. 1992) (citing In re Piasecki, 745 F.2d 1468, 1471-72, 223 U.S.P.Q. 785, 787-88 (Fed. Cir. 1984) and In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988) (citing In re Lalu, 747 F.2d 703, 705, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1988))).

For the Examiner to establish a prima facie case of obviousness, the Examiner must contend that the teachings from the prior art itself or that knowledge generally available to one of ordinary skill in the art would appear to suggest the claimed subject matter to a person of ordinary skill in the art.

Perhaps the Examiner somehow believes that one of ordinary skill in the art could conceivably combine the cited references to produce Applicants' claimed invention. But the Federal Circuit has held that

> obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. (Emphasis added)
> In re Bell, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993) (citations omitted).
>
> Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." (Emphasis added) But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent

> some teaching or suggestion supporting the combination." (Emphasis added)
>
> In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1599 (Fed.d Cir. 1988) (citing In re Keller, 642 F.2d 413, 425, 208 U.S.P.Q.871, 881 (C.C.P.A. 1981) and ACS Hosp. Sys. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984)).
>
> Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.
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> Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) (citing Lindemann, Maschinenfrabrik GmbH v. American Hoist and Derrick Co., 730 F2d 1452, 1462, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Applicant respectfully yet strenuously contends that the Examiner has shown no teaching nor suggestion in any one of the cited references or elsewhere of Applicant's claimed apparatus to support a conclusion of obviousness.

Applicant respectfully submit that the Examiner has fallen into the common trap of hindsight reconstruction, which has been frequently denounced by the Federal Circuit as inappropriate to support a finding of obviousness.

> The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decisionmaker to return to the time the invention was made. "the invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."
> Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1050-51, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988) (quoting Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1138, 227 U.S.P.Q. 543, 547-548 (Fed. Cir. 1985).

It is clear from the Examiner's rejection that, absent the "blueprint" of Applicants' disclosure, the prior art has no suggestion or teaching of Applicants' claimed invention. The Federal Circuit has also stated:

> It is improper to use the patent as an instruction manual to lead to elements of the prior art.
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> Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1568 (Fed. Cir. 1987).
>
> It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious.
>
> In re Fritch, 972 F.2d 1260, 1266, 23 U.S.P.Q.2d 1780,1784 (Fed. Cir. 1992) (citing In re Gorman, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885, 188 (Fed. Cir. 1991)).

It is very clear from the Examiner's language that Applicant's claimed invention is only rendered invalid for obviousness if the Applicant's claimed invention is used as an instruction manual, or template, for modifying the cited prior art. Absent the knowledge gleaned from Applicant's disclosure, there is no suggestion or teaching in the cited prior art or in the general knowledge in the art to support the Examiner's assertion that Applicant's claimed invention would have been obviousness to one of ordinary skill in the art. The Federal Circuit has also stated:

> When prior art references require selective combination...to render obvious a subsequent invention, there must be some reason for the

combination other than the hindsight gleaned from the invention itself.

Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 U.S.P.Q.2d 1434, 1438 (Fed.a Cir. 1988) (citing Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985)).

The Examiner has cited no reason for modifying the cited references to allegedly achieve Applicant's claimed invention other than the knowledge gleaned from Applicant's disclosure. For this reason the Examiner has failed to establish a prima facie case of obviousness based on a combination of these specific references.

Applicants respectfully submit that the arguments above effectively traverses the Examiner's rejections of Claims 1 and 3-16 under 35 U.S.C. § 103(a). Such action is earnestly solicited.

IV. Conclusion

Applicant respectfully submits that Applicant's claimed invention is deserving of patent protection because it describes a useful and functioning system which is patentably distinguishable over the prior art.

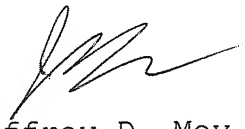
In conclusion, Applicant respectfully submits that this Amendment Letter, including the amendments to the Claims, and in

view of the Remarks offered in conjunction therewith, are fully responsive to all aspects of the possible objections and rejections tendered by the Examiner in the Office Action. Applicant respectfully submits that he has persuasively demonstrated that the above-identified Patent Application, including Claims 1 and 3-16 are in condition for allowance. Such action is earnestly solicited.

If the foregoing does not place the case in condition for immediate allowance, the Examiner is respectfully requested to contact the undersigned for purposes of a telephone interview.

If there are any fees incurred by this Amendment Letter, please deduct them from our Deposit Account NO. 23-0830.

Respectfully submitted,



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